REMARKS

Applicants hereby elect, with traverse, to prosecute claims of Group II, which include claims 10, 25-26, 28, and 30-37 and are drawn to antibodies and methods thereof. Applicants reserve the right to prosecute the non-elected subject matter of claims in subsequent divisional applications.

Applicants submit that the invention encompassed by the claims of Group II (drawn to an antibody) could be examined at the same time as the inventions encompassed by the claims of Groups I and III-VI. For example, a proper search required to determine the novelty of antibodies against the polypeptides would substantially overlap with a search of the prior art to determine the novelty of the polypeptide claims of Group I.

Further, Applicants submit that claims substantially corresponding to the pending claims have already been examined and allowed in the ancestor applications. The allowed claims are as follows:

US 5,776,753

1. An isolated and purified polynucleotide sequence which encodes the peroxisomal thioesterase of SEQ ID NO:1 or a variant thereof which differs by one amino acid and retains enzymatic activity.

2. A composition comprising the polynucleotide sequence of claim 1.

3. A polynucleotide which is complementary to the polynucleotide of claim 1.

4. An isolated and purified polynucleotide sequence comprising SEQ ID NO:2.

5. A composition comprising the polynucleotide sequence of claim 4.

6. A polynucleotide sequence which is complementary to the polynucleotide sequence of claim 4.

7. An expression vector containing the polynucleotide of claim 2.

8. A host cell containing the vector of claim 7.

9. A method for producing a polypeptide comprising the amino acid sequence of SEQ ID NO:1, the method comprising the steps of:

a) culturing the host cell of claim 8 under conditions suitable for the expression of the polypeptide; and

b) recovering the polypeptide from the host cell culture.

US5,911,984

1. A substantially purified peroxisomal thioesterase comprising the amino=acid sequence of SEQ ID NO:1, or fragments thereof which retain enzymatic activity, or fragments thereof which bind antibodies specific for said thioesterase.

2. A pharmaceutical composition comprising a substantially purified peroxisomal thioesterase having the amino acid sequence of SEQ ID NO:1 in conjunction with a suitable pharmaceutical carrier.

3. A method for treating a disorder associated with fatty acid metabolism comprising administering to a subject in need of such treatment an effective amount of the pharmaceutical composition of claim 2.

US6,210,890

1. A method for detecting a polynucleotide encoding a polypeptide comprising SEQ ID NO:1 in a biological sample comprising the steps of:

a) hybridizing an isolated and purified polynucleotide which is complementary to a polynucleotide encoding a polypeptide comprising SEQ ID NO:1 to nucleic acid material of a biological sample, thereby forming a hybridization complex; and

b) detecting said hybridization complex, wherein the presence of said complex correlates with the presence of a polynucleotide encoding a polypeptide comprising SEQ ID NO:1 in said biological sample.

2. The method of claim 1, wherein the nucleic acid material is amplified by the polymerase chain reaction.

3. The method of claim 1, wherein the method is carried out in a high-throughput format.

4. A composition comprising an isolated and purified polynucleotide comprising the polynucleotide sequence of SEQ ID NO:2 or its complement and a detectable label.

5. A method of detecting a target polynucleotide in a biological sample, said target polynucleotide comprising the sequence of SEQ ID NO:2, said method comprising:

a) combining the biological sample with a probe comprising at least 20 contiguous nucleotides, said probe comprising a sequence that is complementary to said target polynucleotide in the biological sample, under conditions suitable for formation of a hybridization complex between said probe and said target polynucleotide; and

b) detecting said hybridization complex, wherein the detection of said hybridization complex is correlated with the presence of said target polynucleotide in the biological sample.

Groups I and III are thus drawn to substantially the same invention as previously allowed in US 5,776,753, US 5,911,984, and US 6,210,890, but are of a different scope from the previously allowed claims. Applicants submit that these claims should be examined together, since there would appear to be minimal additional burden on the Examiner to examine these claims in addition to the antibody claims elected in the present application, particularly in view of the searches and examination which were already conducted with respect to the previously issued claims and the additional burden on Applicants to file, prosecute and maintain yet another application in this family. Applicants therefore respectfully request the Examiner to consider claims of Group I and III.

Moreover, the claims of Groups IV-VI are method claims which depend from antibody claim 10 of Group II. Therefore, upon allowance of Group II claims, the method claims of Groups IV-VI should be rejoined and considered together, in accordance with the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rules, upon allowance of product claims, for rejoinder of method claims covering the same scope of products.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,

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